


File

Notice of Allowability	Application No. 08/884,073	Applicant(s) Hawkins et al.	
	Examiner Andrew Wang	Group Art Unit 1809	

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

☒ This communication is responsive to interview on Dec. 20, 1997.

☒ The allowed claim(s) is/are 9, 10, and 12.

☐ The drawings filed on _____ are acceptable.

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

☒ Applicant MUST submit NEW FORMAL DRAWINGS

☐ because the originally filed drawings were declared by applicant to be informal.
☒ including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. 7.
☐ including changes required by the proposed drawing correction filed on _____, which has been approved by the examiner.
☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

☒ Notice of References Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152
☒ Interview Summary, PTO-413
☒ Examiner's Amendment/Comment
☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
☒ Examiner's Statement of Reasons for Allowance

Serial Number: 08/884,073

Art Unit: 1809

7/e

Page 2

#7/C
chr
1-6-98

EXAMINER'S AMENDMENT

Election/Restriction:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 9, 10, 12, 13, and 20, drawn to protein and treatment method, classified in class 530, subclass 350.
 - II. Claim 7, 17, and 19, drawn to diagnostic method with oligonucleotides, classified in class 536, subclass 24.31.
 - III. Claims 6, 14, and 16, drawn to antisense molecules and treatment method, classified in class 536, subclass 24.5.
 - IV. Claims 11 and 18, drawn to an antibody, classified in class 424, subclass 139.1.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions of Groups I and II and III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the protein, antisense oligos, hybridization probes, and antibodies are unrelated because each has a different structure, function, composition and/or purpose as compared to the each other.

Art Unit: 1809

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and because the search required for one of the groups is not required for another, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Lucy Billings on December 4, 1997 a provisional election was made without traverse to prosecute the invention of Group I, claims 9, 10, 12, 13, and 20. Affirmation of this election must be made by applicant in responding to this Office action. Claims 6, 7, 11, 14, and 16-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312.

Art Unit: 1809

To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ms. Lucy Billings on December 16, 1997.

7. The application has been amended as follows:

Claims 6, 7, 11, 13, 14, and 16-20 have been canceled.

In claim 12, "pharmaceutical composition for treating a condition associated with excessive expression of metalloproteinase comprising an effective amount of" has been replaced with --composition comprising--.

8. The following is an examiner's statement of reasons for allowance: The prior art does not teach the polypeptide of SEQ ID NO: 2. The closest prior art is found in Cook, *et al.*, who teach an amino acid sequence of the tissue inhibitor of metalloproteinase-2 (TIMP-2) that has about 50% similarity to the amino acid sequence of SEQ ID NO: 2. Hence, the amino acid sequence of the instant application is distinct from the prior art is free of the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

Art Unit: 1809

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Wang whose telephone number is (703) 306-3217. The examiner can normally be reached on Monday to Thursday from 8 a.m. to 4:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached on (703) 308-4003. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Andrew Wang
December 22, 1997



JOHN L. LeGUIYADER
PRIMARY EXAMINER
GROUP 1800